



THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant : Mark Parrington, et al.
App'l'n. No. : 09/190,246
Filed : November 13, 1998
Title : ALPHAVIRUS VECTORS FOR PARAMYXOVIRUS VACCINES
Grp./A.U. : 1632
Examiner : Michael C. Wilson
Docket No. : 1038-865 MIS/jb
Date : July 4, 2003

BY COURIER

Mail Stop Amendment
Commissioner of Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
U.S.A.

RESPONSE

Sir:

This Communication is in response to the Office Communication of May 5, 2003.

Petition is hereby made under the provisions of 37 CFR 1.136(a) for an extension of one month of the period for response to the Office Action. Our cheque in respect of the prescribed fee is enclosed.

In the Communication, the Examiner indicates that the reply filed February 18, 2003 is not fully responsive to the prior Office Action on the basis that the response does not identify where support for the newly-added limitations are to be found in the disclosure.

The Amendments made to the claims were made specifically to attend to the Examiner's assertion of new matter under 35 USC 112, first paragraph, and indefiniteness under 35 USC 112, second paragraph.

The Examiner had objected that the specification does not teach that the second sequence is downstream of the first and, in this regard, claim 1 was amended to recite that the second sequence is inserted into a region of the first DNA sequence which is non-essential for replication. This language finds textual basis in the statement of invention appearing on page 7 of the specification (specifically page 7, lines 28 to 31 of applicants file copy of the specification – all references to page and line numbers refer to the copy of the specification in attorney's file).

The Examiner had objected that claim 1 was indefinite with respect to the definition of the first DNA sequence on the basis that it is unclear how "complementary" the DNA sequence is to the RNA sequence. In response, claim 1 was amended to recite that the DNA sequence is wholly complementary to the RNA sequence.

The term "complementary" or "complement" always refers to something which is complementary according to the genetic code of the DNA/RNA sequences referred to. Thus, the natural meaning of the term is that the recited sequence is the complete complement of the other sequence and hence the term "wholly" is not really required, but was inserted because of the Examiner's comments. While the term "wholly" does not specifically appear in the specification, it is submitted that, from the description, it is the natural meaning of the term which is employed.

The Examiner indicated that it is unclear whether the phrase "and having the complement of complete alphavirus RNA genome replication" refers to the first sequence or the RNA genome. As pointed out in the last response, the term "and" specifically recites that the first DNA sequence has the complement of the complete alphavirus genome replication regions. It is a straining of the previous language to suggest otherwise. However, in view of the Examiner's comment, the term "and" was replaced by "said first DNA sequence". It is clear, for example, from original claim 9 and the corresponding disclosure on page 8, line 20 to 22 that the first DNA sequence is referred to.

The Examiner considered the second DNA sequence to be indefinite on the basis that the species of the Markush group was not clearly set forth. To simplify the language, the definition of the second DNA sequence was amended to refer simply to RSV F or G protein fragments lacking the transmembrane anchor and cytoplasmic tail, contained in original claim 7 and disclosed on page 8, lines 17 to 19.

The Examiner considered that third DNA sequence to be indefinite. Claim 1 was amended to change "and comprising" to "said DNA sequence". Basis can be found in original claim 12, which recites that the third DNA sequence comprises a pair of splice sites that prevent aberrant mRNA splicing *in vivo* and also the disclosure on page 8, lines 23 to 25.

The amendments made to claims 14, 15 and 16 are essentially editorial changes.

In addition, the Examiner indicated that the disclosure would not be amended by the Examiner to update the status of the applications referred throughout the specification as requested. This request is repeated for the following reasons.

At an Interview on this application held December 6, 2000, it was appreciated that the pagination of the specification filed with the application in the PTO was different from the pagination of the applicants attorneys file copy. At the time, applicants attorney asked to borrow the Examiner's file to ascertain the correct pagination, but the Examiner refused.

This refusal has lead to subsequent misunderstandings as to amendments to be made to the specification, specifically updating the status of information related to pending applications. The Examiner is aware of the correct location of the references to pending applications (para. 2 of the Office Action) whereas applicants attorney is not. The information required to update the status was provided in the Amendment filed February 18, 2003.

It would, therefore, be greatly appreciated if the Examiner would make the updates by Examiner's Amendment.

It is submitted that this paper and the Amendment filed February 18, 2003 constitute a full response to the prior Office Action.

It is believed that this application is now in condition for allowance and early and favourable consideration and allowance are respectfully solicited.

Respectfully submitted,



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